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Mail Stop Appeal Brief
Commissioner for Patents
Board of Patent Appeals and Interferences
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT
Attorney Docket No.: 019491-004510US
Client Ref. No.: 45US

On May 5, 2005

TOWNSEND and TOWNSEND and CREW LLP

By: Sylvia E. Arnold
Sylvia E. Arnold

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Leinfellner et al.

Application No.: 09/495,622

Filed: February 1, 2000

For: ELECTRONIC IN-APPLICATION
POSTCARDS

Customer No.: 20350

Confirmation No. 5097

Examiner: Gregory J. Vaughn

Technology Center/Art Unit: 2178

APPELLANT'S REPLY BRIEF UNDER 37
C.F.R. 1.193(b)(1)

Mail Stop Appeal Brief
Commissioner for Patents
Board of Patent Appeals and Interferences
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is filed in triplicate pursuant to 37 C.F.R. §1.193(b)(1), in response to the Examiner's Answer ("the Answer"), mailed March 7, 2005. A request for an oral hearing pursuant to 37 C.F.R. §1.194 will not be submitted.

I. Status

In the Answer, the Examiner has taken the position that all of the pending claims remain rejected with the exception of claim 8, which the Examiner indicated as being allowable. In response to this indication, Appellants filed an Amendment under 37 CFR 1.116 on April 15, 2005, canceling claim 8 with prejudice to file a continuation application directed thereto. Accordingly, claims 1-7 and 9-21 are the pending rejected claims to which this Reply Brief is directed.

II. Rebuttal to Examiner's Response to Arguments

In the Answer, the Examiner offered additional support for the rejection of the claims. Beginning at page 5, the Examiner stated that "SnagIt, the mail software and a plurality of other software components are operating concurrently in one environment, i.e., the personal computer", and "as recited in the claims, nothing requires the invention claimed herein to operate or be contained in a single file or program module." Here, the Examiner is acknowledging that a separate mail application (the "mail software") is used to send messages generated by SnagIt. In contrast, the present invention recites "sending the composite message from within the game application to the intended recipient over the network." Although this limitation may not require the claimed invention to operate or be contained in a single file or program module, this limitation distinguishes over SnagIt in that no separate mail application is needed as is the case with SnagIt. Rather, the message is sent from within the game application to the intended recipient over the network, and not by a separate mail client as is required by SnagIt. Unlike SnagIt, the claimed invention may be useful on computers that are not personal computers and upon which a separate mail client cannot be installed.

The Examiner continued by stating at page 5 that "the claimed application/game that the screenshot is derived from will require a plurality of files or program modules, including at least an operating system, memory management software, display drivers, and the application/game software", and "[f]urthermore the claimed messaging function will require at least network drivers/software, messaging software, display drivers etc. in order to function." Appellants agree that the claimed invention would require the use of an Operating System (OS)

and other components such as display drivers and memory management software. Indeed, any computing system software requires interaction with an Operating System and other components such as display drivers, and in the case of network communications, network drivers, to operate the computer hardware properly. Appellants disagree, however, with any characterization or implication that the claimed invention requires a mail client separate from the game application. An Operating System itself does not include e-mail application functionality. In order to send an e-mail, a separate application with such functionality must be installed by the user. In the Windows Operating System environment, for example, Microsoft Outlook (e-mail client) is an application separate from the Windows OS. The Examiner referred to "messaging software" as a required component for the claimed messaging function to function properly. Appellants are not sure whether this term was used to imply a separate mail client. In any event, as with any software running on a computer system, the claimed invention would need to interact with OS functionality to properly function on the computer hardware, but it does not require a separately installed mail client because any "messaging software" used to send a composite message to a recipient over a network is part of the application/game software. This is clear from the language "from within the game application" recited in the claims.

The Examiner then concluded by simply stating at page 5 to page 6 that "SnagIt, operating within the confines of a standard computing environment, anticipates the claimed limitation of "generating and sending the composite message from within the game application". However, SnagIt clearly requires an external mail client in addition to the OS. In fact, SnagIt is replete with references and statements to the effect that an external mail client is required to send the composite message generated by Snagit as an e-mail message. See, e.g., Figure 3 of SnagIt, where it is stated that to send a message, the Send Mail option needs to be selected to "route your captured files to a 32-bit MAPI client." It is further stated in Figure 3, in the "Tip" section, that "[t]he output will be directed to your mail program for handling." Further, in Figure 9, in reference to sending screen shots to someone using E-mail, it is stated that "if you need to send screen shots to someone or a group using E-mail and your E-mail system is MAPI compliant ...". (emphasis added) This shows that an external mail client is required. Moreover, in Figure 6, it is stated that "[f]or mail output, a 32-bit MAPI mail client (for example, Microsoft Exchange) must be configured." (emphasis added) Lastly, and perhaps most pertinent, in Figure

3 it is stated that "[t]he Send Mail output option is only supported if you have a 32-bit MAPI mail client installed (e.g., Microsoft Exchange)."

The Examiner has also acknowledged that a separate mail client is needed in conjunction with SnagIt in the Answer at page 5. Thus, to mail a screenshot captured by SnagIt, a computer system would require at least four components: an OS, the application from which the screenshot is captured, SnagIt for capturing the screenshot, and the external mail client to send the captured screenshot. In contrast, a system according to the claimed invention requires only two components: an OS and the game/application module, which itself includes the screen capture and mailing functionality.

In making the concluding allegation at page 5 to page 6, the Examiner also appears to ignore the fact that the limitation concludes with the recitation of "to the intended recipient over the network". That is, the limitation discussed is "sending the composite message from within the game application to the intended recipient over the network." As discussed in the Appeal Brief, and as will be discussed below with reference to the Examiner's allegations in the Answer regarding the "hotkey combination" of SnagIt, SnagIt only teaches sending a composite message to an external mail client. The external mail client must then be accessed to send an e-mail message including the screenshot. This would be disruptive to gameplay where the application from which a screenshot is taken is a game application; the user would need to exit the game application, access the external mail program to send the e-mail and then, if desired, return to the game application to restart gameplay. The presently claimed invention advantageously allows a user to send a message from within the game application. For example, the user need only select a single command to pause gameplay, and then compose a message, send the message and resume gameplay when the mail has been sent, with the gameplay in the same place where the user left it, leading to minimal disruption.

Moving on to a discussion of the hotkey combination, the Examiner stated at page 6 of the Answer that "SnagIt can be reconfigured to automatically output the capture information in the form of an electronic mail message", and that "Figure 3 of the SnagIt Version 4.3 help system discloses the steps to be performed to change the SnagIt output settings so that an

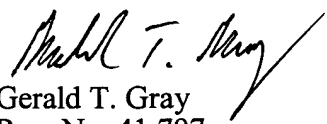
electronic mail message (not printer output) is generated upon activation of the hot key combination by the user." Nonetheless, SnagIt still requires an external mail client to actually send the message to a recipient over a network. As above, SnagIt is replete with references and statements to the effect that an external mail client is required to send the composite message generated by Snagit as an e-mail message. Thus, the "hotkey combination" of SnagIt may teach automatically capturing a screenshot and formatting the screenshot in a file for use in an electronic mail message, but it does not also teach sending the message to a recipient over a network. Nonetheless, the Examiner stated at page 7 of the answer that "SnagIt anticipates 'sending of a message using a hotkey combination'." Again, the Examiner failed to include the remainder of the recited limitation "to the intended recipient over the network." It thus appears that the Examiner may be confusing the idea of sending a message using the hotkey combination to the mail client, which *is* taught by SnagIt as just discussed, with the recited limitation of "sending the composite message from within the game application to the intended recipient over the network", which is neither taught nor suggested by SnagIt.

III. Conclusion

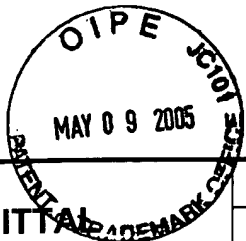
In view of the foregoing, Appellants believe all claims now pending in this Application are patentably distinguished over SnagIt and are in condition for allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


Gerald T. Gray
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PTO/SB/21 (09-04)

AE
2178
JFW**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/495,622
Filing Date	February 1, 2000
First Named Inventor	Leinfellner, Richard
Art Unit	2178
Examiner Name	Gregory J. Vaughn
Attorney Docket Number	019491-004510US

ENCLOSURES (Check all that apply)

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|---|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form
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<input type="checkbox"/> Amendment/Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
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<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
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Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Townsend and Townsend and Crew LLP
Signature	
Printed name	Gerald T. Gray
Date	May 5, 2005

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Sylvia E. Arnold

Date

May 5, 2005

MAY 09 2005

PTO/SB/17 (12-04)

Effective on 12/09/2004
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 0)

Complete if Known

Application Number 09/495,622
Filing Date February 1, 2000
First Named Inventor Leinfellner, Richard
Examiner Name Gregory J. Vaughn
Art Unit 2178
Attorney Docket No. 019491-004510US

METHOD OF PAYMENT (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity		Small Entity		Small Entity		
	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity	
	Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)** **Multiple Dependent Claims**
 _____ -20 or HP = _____ x _____ = _____
 Fee (\$) Fee Paid (\$)
 HP = highest number of total claims paid for, if greater than 20
Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**
 _____ -3 or HP = _____ x _____ = _____
 HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**
 _____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

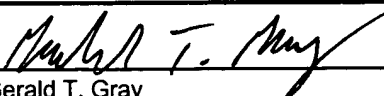
Non-English Specification, \$130 fee (no small entity discount)

Other: Filing a reply brief

Fees Paid (\$)

0

SUBMITTED BY

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Name (Print/Type)	Gerald T. Gray		Date May 5, 2005